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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/421,038	10/20/1999	CHASE A. HAFNER	1668	3569

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EXAMINER

CHAMPAGNE, DONALD

ART UNIT PAPER NUMBER

2162

DATE MAILED: 03/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/421,038

Applicant(s)

HAFNER ET AL.

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 20 October 1999 is: a) ☒ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 6 March 2002 have been fully considered but they are not persuasive. An explanation is given in para. 11-16 after the following final rejection.

Claim Rejections - 35 USC § 102 and 35 USC § 103

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by, or, in the alternative, under 35 U.S.C. 103(a) as obvious over Benyacar et al.
5. Benyacar et al. teaches a method, system and computer readable medium for managing information and rendering discounts in a billing system, the method comprising (col. 10 lines 44-59): receiving a customer record (*AMA record 370*) at billing system 140, where the record includes the data shown in Fig. 3 (col. 7 line 16 to col. 10 line 27); executing the steps of Fig. 2 with the system of Fig. 1 (col. 5 line 41 to col. 7 line 15 and col. 10 lines 28-43), which reads on establishing both a rule-based accumulation engine and a rule-based discount engine; and generating the caller's and sponsor's billing records from the *AMA record*, including rendering discounts applicable to the customer.

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6. Benyacar et al. does not teach accumulating the data in a plurality of predetermined target accumulators. However, under the principles of inherency (MPEP § 21112.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, it is noted that the reference teaches (col. 10 lines 44-59) substantially manipulating the data, which inherently entails placing data in computer memory locations, which reads on predetermined target accumulators.
7. Claims 1-4, 6-14 and 16-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Jagadish et al.
8. Jagadish et al. teaches (independent claims 1, 10 and 11) a method, system and computer readable medium for managing information and rendering discounts in a billing system, the method comprising: receiving a customer record (*AMA record*) at *billing analysis system 112* (col. line 22); and executing the steps of Fig. 2 with the system of Fig. 1a (col. 4 line 35-49), which reads on establishing both a rule-based accumulation engine and a rule-based discount engine, processing the record and accumulating the data in *SD 113*, in a plurality of computer memory cells, which reads on a plurality of predetermined target accumulators, and rendering discounts applicable to the customer, which reads on processing the plurality of target accumulators with the discount engine to render discounts applicable to the customer.
9. Jagadish et al. also teaches: (claims 2-4, 7, 8, 12-14, 17 and 18) the Fig. 2 series of process steps to be applied based on the number of customer lines, which reads on establishing a rules table to apply at least one rule or function when dictated by the record type, and establishing at least one simple rule for processing the record to evaluate discount application; (claims 6 and 16) adding the number of the telephone line to the record (col. 4 lines 47-54), which reads on assigning a logical name to a source field, where the accumulation engine processes the record using the logical name; and (claims 9 and 19) establishing at least one compound rule composed of simple rules (col. 5 lines 10-23).
10. Claims 5 and 15 are rejected under 35 U.S.C. 102(e) as being obvious over Jagadish et al. Jagadish et al. does not teach that the rules table directs the accumulation engine to pass data directly to a target accumulator when dictated by the record type. Because the initial purpose of the reference invention is to aggregate all the phone line records for any given

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customer, it would have been obvious to one of ordinary skill in the art, at the time of the invention, that processing resources could be saved by bypassing this step, and passing the data directly to the target accumulators in *SD 112*, when the customer has only one line.

11. Applicant argued (Paper No. 3 pp. 3 and 4) that both of the relied upon references fail to describe or suggest the specific method claimed for managing information and rendering discounts, comprising a "rule based accumulation engine" and a "rule based discount engine" (claim 1).
12. The crux of the issue is the definition of "rule based accumulation engine" and "rule based discount engine". The only *generic* guidance in the application is provided in one paragraph at lines 8-15 on p. 2 of the specification. The terms are also described in subsequent paragraphs, but in the context of "a preferred embodiment".
13. The material provided in the specification does not provide "clear definition" of the terms, as required by MPEP § 2111.01: The specification does not establish the metes and bounds of the terms "rule based accumulation engine" and "rule based discount engine". A "clear definition" must unambiguously establish what is and what is not included. It is helpful if definitions are gathered in a section labeled definitions, or are preceded by phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...".
14. In the instant case, the examiner is required to give the terms their broadest reasonable interpretation (MPEP § 2111), which the examiner judges to be: first, any engine (processor) which uses some rules to accumulate data "in a plurality of pre-determined target accumulators", and, second, an engine which processes the plurality of target accumulators "to render discounts applicable to the customer". That is the definition implied by the one paragraph at lines 8-15 on p. 2 of the specification.
15. As noted in para. 5 and 8 above, the references do teach such engines.
16. Applicant argued (Paper No. 3 p. 4) that the citation (col. 4 lines 47-54) in the rejection of claims 6 and 16 (para. 9 above) merely describes ANI, and "fails to describe the claimed assigning of a logical name to a source field". The "number of a telephone line" constitutes a logical name, and passing it "to the billing analysis system" reads on its assignment to a source field.

Conclusion

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
18. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.
19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 703-308-3331. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications may be sent directly to the examiner at 703-746-5536.
20. The examiner's supervisor, Eric Stamber, can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular official communications and 703-746-7238 for After Final official communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.
21. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

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A handwritten signature in black ink, appearing to read "Donald L. Champagne", written in a cursive style.

Donald L. Champagne
Examiner
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28 March 2002